

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-84 are currently pending. Claims 1-84 were generally rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell in view of either Stern, Barrett, or a combination of the two latter references. Claims 13, 25, 54 and 68 have now been amended to overcome these rejections. No new matter has been entered. Applicants respectfully traverse these rejections.

Applicants thanks Examiner Robinson for her time on Friday, November 22, 2002 to discuss these rejections with us. As was emphasized by the Applicants during the interview, the current invention discloses a system and method for the electronic viewing of a document. Further, this is accomplished without having to produce a hard copy of the document. Instead, data representing the document is retrieved from electronic storage, such as, for example, a print queue designed to temporarily hold print data before the data is directed to the printer processor for actual generation of a hard copy of the document. In contrast, the prior art, as cited, fails to disclose the ability to place a document into an electronic format for viewing without requiring a hard copy of the document.

Specifically, U.S. Patent No. 5,963,966 to Mitchell et al. ("Mitchell") is cited for a method of providing a document in electronic form. However, Mitchell does not obtain document data from electronic storage such as a print queue where the data has been converted into a format appropriate for printing, i.e. encapsulated postscript (EPS) format. Further, Mitchell does not convert this printing data into a plurality of viewable files without first having the documents produced in hard copy. Instead, the Mitchell system relies on obtaining "paper documents [that] are automatically converted into a hypertext-based format." (See Mitchell, Abstract) This need to obtain and scan hard copies of the documents is the first step of Mitchell's process for producing electronic documents. Without this fundamental step of "translating paper to electronic form", Mitchell cannot function. (See Mitchell, 6:35-38) As a result of this scanning requirement, Mitchell must run the data through an optical character recognition (OCR) program, which requires significantly more processing of the data, and ultimately leads to the generation of an imperfect copy containing a significant amount of errors.

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U.S. Patent No. 5,963,966 to Barrett et al. ("Barrett") is merely cited for its disclosure of a print queue. Barrett discloses an office automation system that includes a print queue. (See Barrett, 11:5-60) Further, Barrett uses this print queue in the traditional sense, where an "image print server 328 puts the data into a temporary print file and places a print request on the system print queue 346, which the general purpose mechanism for printing." (See Barrett, 11:52-56)

U.S. Patent No. 6,161,107 to Stern ("Stern") is merely cited in the Office Action for its disclosure of a persistent electronic storage medium. Stern discloses a server for storing information, where the information is analyzed by content and then subdivided into individual information components that are maintained in a database. (See Stern, 15:20-32)

In contrast to the secondary references discussed above, the primary reference of Mitchell deals with the conversion of a paper document into an electronic format by first scanning the hard copy of the document and then processing it using optical character recognition. Neither Barrett nor Stern deals with the capturing of a paper document by scanning. Barrett deals with an office automation system that includes the ability to print hard copies of documents, which is the opposite goal of Mitchell, while Stern is concerned with a computer server. Accordingly, neither of the secondary references relates to the subject matter of Mitchell, and as such, there would have been a lack of motivation at the time of conception of the current invention to combine these references to create a single apparatus.

Furthermore, even if the cited references were to be combined, the resultant system would fail to disclose the system and method called for by the present application. Specifically, independent method claim 1, and similarly method claim 40, calls for a method of providing a document in electronic form, including the steps of:

Providing a print queue of printing data for producing the document in a printed format;

Converting the printing data in the print queue into a plurality of viewable files, each viewable file representing one of the pages of the document and preserving the printed format, without an intermediary step of producing hard copies of the pages

(emphasis added).

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Similarly, independent apparatus claims 13, 25, 54 and 68 have all been amended to call for either a system or medium for storing a document in electronic form, including "*a viewable file generated by data stored in a print queue.*"

In contrast, none of the cited references disclose the ability to provide a document in electronic form that includes the advantageous step of "converting the printing data in the print queue into a plurality of viewable files ... without an intermediary step of producing hard copies of the pages", or an apparatus that includes "*a viewable file generated by data stored in a print queue.*"

For the above reasons, Applicants respectfully request that the §103 rejections based on Mitchell, Stern and/or Barrett be withdrawn.

CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Any fees associated with the filing of this paper should be identified in an accompanying transmittal. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge Account No. 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

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Marked Up Version of the Amended Paragraphs

Page 9, last paragraph:

The outputs of steps 113 and ~~117~~ 115, namely, the optimized image files and advertisement rectangle definition files, are sent to an archiving facility over a suitable communication network in step 117. It is preferable not to send information to the archiving facility earlier in the process to avoid tying up the network with the large EPS files. The optimized image files and the advertisement rectangle definition files can be sent as they are created or held and then sent as a batch for the entire book.

Marked Up Version of the Amended Claims:

13. (Once Amended) A persistent electronic storage medium for storing a document in electronic form, the document having a plurality of pages, the medium having written thereon:

(a) a plurality of viewable files, each viewable file generated from data stored in a print queue, said each viewable file representing one of the pages of the document and preserving a printed format of said one of the pages;

(b) an index representing an organization of the document; and

(c) software to view the viewable files and to search through the viewable files in accordance with the index.

25. (Once Amended) A system for allowing a user to access a document in electronic form, the document having a plurality of pages, the system comprising:

(a) a persistent electronic storage medium having written thereon:

(i) a plurality of viewable files, each viewable file generated from data stored in a print queue, said each viewable file representing one of the pages of the document and preserving a printed format of said one of the pages;

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- (ii) an index representing an organization of the document; and
- (iii) software to view the viewable files and to search through the viewable files in accordance with the index; and
- (b) a computer for accessing the medium, running the software and allowing the user to interact with the software.

54. (Once Amended) A persistent electronic storage medium for storing a page of a document in electronic form, the document having a plurality of pages with one or more items on each page, the page having a selected item thereon, the medium having stored thereon:

- (a) highlighting information representing a position of the selected item on the page;
- (b) a viewable file generated from data stored in a print queue, the viewable file representing the page and preserving a printed format of the page; and
- (c) software to view the viewable file and to highlight the position of the selected item on the page.

68. (Twice Amended) A system for allowing a user to access a page of a document in electronic form, the document having a plurality of pages with one or more items on each page, the page having a selected item thereon, the system comprising:

- (a) a persistent electronic storage medium storing, in computer-readable form:
 - (i) highlighting information representing a position of the selected item on the page;
 - (ii) a viewable file generated from data stored in a print queue, the viewable file representing the page and preserving a printed format of the page; and
 - (iii) software to view the viewable file and to highlight the position of the selected item on the page; and
- (b) a computer for accessing the medium, running the software and allowing the user to interact with the software.